

REMARKS

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

The Examiner's communication of April 26, 2007, together with the references cited therein, have been given careful consideration. After such consideration, and in an earnest effort to complete the prosecution of this application, the Applicants have set down the following arguments in support of the patentability of claims 1-20.

Claims 1, 11, and 16 have been rejected as being inadequately described. The Office Action cites the Specification, page 6, lines 3-7 and pages 8-9, lines 23-24 & 1 for the proposition that "the broadcast message is for the other active mobile devices, but not broadcast to the first device" (Office Action, page 2, para. 2). As stated in claims 1, 11, and 16, the direct communication is between the first and second devices (i.e., communication occurs in both directions). As stated in the Specification, page 6, lines 3-7 and pages 8-9, lines 23-24 & 1, one mobile device may initiate the communication. This does not necessarily dictate

that the communication ends there. Thus, the gateway device provides broadcast messages in both directions (Specification, page 6, lines 7-13 and page 9, lines 4-13). Please review Table 1 for a detailed description of this communication. The subject matter of claims 1, 11, and 16 is adequately described.

Regarding claim 16, the Office Action states that "tangible medium" is not supported by the Specification. Pages 26-28 of the Specification describe the following terms, among others: a memory bus, a memory controller, a peripheral bus, a local bus using any of a variety of conventional bus architectures, read only memory (ROM), random access memory (RAM), a hard disk drive, a magnetic disk drive, an optical disk drive, associated computer-readable media for nonvolatile storage of data, data structures, computer-readable media, a CD, magnetic cassettes, flash memory cards, digital video disks, and Bernoulli cartridges. It is respectfully submitted that these terms describe the "tangible medium" of claim 16 sufficiently to satisfy 35 USC §112, first paragraph. However, if the Examiner wishes to substitute one of the above

terms for "tangible medium", Applicant's representative will consider it.

Claims 1-14 and 16-20 have been rejected as unpatentable over Tsutsumi et al., US 2003/0078034 in view of Dorenbosch et al., US 2003/0235184 and Fishman et al., US 2002/0103935. Claim 15 has been rejected as unpatentable over Tsutsumi et al. in view of Dorenbosch et al., Fishman et al., and Mercer, US 2004/0198322.

The M.P.E.P. sets forth the following criteria for an obviousness rejection under 35 U.S.C. §103:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, MPEP §706.02(j).

To again assist the Examiner in reconsidering this application, the following is a presentation based on the language employed in claim 1 when read on the embodiment

presented in Figs. 1-2 herein. Claim 1 recites a communication system including a data concentrator computer, a mobile gateway device, a first mobile data acquisition device, and a second mobile data acquisition device. The mobile gateway device, separate and distinct from said data concentrator computer, communicates with the data concentrator computer. The first mobile data acquisition device communicates with the mobile gateway device. The second mobile data acquisition device communicates with the mobile gateway device. The mobile gateway device allows direct communication between the first and second mobile data acquisition devices, through broadcast messages from the mobile gateway device to the first and second mobile data acquisition devices, without communication with the data concentrator computer.

First, the Office Action cites paragraphs 5 and 11 of Dorenbosch et al. for motivation that it would have been obvious to "incorporate a gateway device separate from the data concentrator computer and a broadcast message from the gateway to first and second mobile devices" into Tsutsami's

network device "in order to provide a high-speed floor control with minimum delay" (Office Action, page 4).

While this statement of motivation is generally a worthwhile endeavor, this statement does not specifically address the modifications of Tsutsumi, by Dorenbosch et al., necessary to disclose the communication system recited in claim 1. Further, this general statement of motivation is sufficiently vague to amount to no motivation at all.

Second, the Office Action cites paragraph 10 of Fishman et al. for motivation that it would have been obvious to "incorporate a mobile gateway device as taught by Fishman into a gateway device separate from the data concentrator computer and a broadcast message from the gateway to first and second mobile devices as taught by Dorenbosch into Tsutami's network device in order to better customize content" (Office Action, page 4).

Again, while this statement of motivation is generally a worthwhile endeavor, this statement does not specifically address the modifications of Tsutsumi, by Fishman et al., necessary to disclose the communication system recited in

claim 1. This general statement of motivation also is sufficiently vague to amount to no motivation at all.

Claim 1, as well as claims 2-10 which depend from claim 1, are in condition for allowance.

Please note that no motivation to combine references has been stated with regard to independent claims 11 and 16. Applicant's representative has assumed that the Office Action intended for the same motivation utilized for claim 1 to also be utilized for claims 11 and 16. In such a case, the previous arguments are applied in support of the patentability of claims 11 and 16 as well.

Regarding claims 14 and 19, the Office Action merely states that Dorenbosch et al. discloses third and fourth devices. The Office Action provides no specific motivation for modifying Tsutami to include these features of Dorenbosch et al. As stated above, without motivation to combine proposed references, a *prima facie* case of obvious is not established.

Claims 11 and 16, as well as claims 12-15 and 17-20 which depend from claims 11 and 16, respectively, are in condition for allowance.

Applicant's representative restates the following argument, previously stated with regard to the obviousness rejection of claims 14-20, and now repeated with regard to the obviousness rejection of claims 1-20. Applicant's representative respectfully requests that the Examiner reconsider this argument regarding the unique nature and patentability of computer-related subject matter as determined by the Federal Circuit.

The structure of a computer, or computer-implemented system, programmed to carry out an algorithm is limited by the disclosed algorithm. See WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1348 (Fed. Cir. 1999). A new machine (a special purpose computer) is created when a general purpose computer is programmed to carry out an algorithm for performing one or more particular functions. Id. citing In Re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (*en banc*). When a general purpose computer is programmed to perform a

particular function by using a discovery not specified in the prior art, the resulting device or system would not be obvious under 35 U.S.C. §103 "because one not having knowledge of the [inventor's] discovery simply would not know what to program the computer to do." See In re Prater, 415 F.2d 1393, 1397-98 (CCPA 1969).

For an obviousness rejection under 35 U.S.C. §103, the prior art must be analyzed at the time the invention was made. The use of the teachings of the present invention to find obviousness is impermissible.

Obviousness must not be read into an invention on the basis of applicant's own statements; that is, the prior art must be viewed without reading into that art the applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention obvious.

In Re Sponnoble, 160 USPQ 237, 243 (CCPA 1969) (emphasis in original). Accordingly, the Examiner must consider only the teachings of the prior art references.

The features of claims 1-20 are not taught by

Tsutsumi et al. According to WMS Gaming Inc., 184 F.3d at 1348, the systems and computer program products of claims 1-20 define a communication algorithm. Since Tsutsumi et al. admittedly fails to teach or suggest all of the features of claims 1-20, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to combine Tsutsumi et al. with the other references.

Additionally, when an algorithm is not taught or suggested by a prior art reference, one of ordinary skill in the art would not know what to program a computer to do. See e.g., In re Prater, 415 F.2d at 1397-98. Thus, a new system or computer program product has been created when a computer is programmed to carry out an algorithm to perform a particular function, as in claims 1-20. WMS Gaming Inc., 184 F.3d at 1348. Therefore, it is respectfully submitted that it would not have been obvious for one of ordinary skill in the art to modify Tsutsumi et al. as suggested by the Office Action. Thus, it is respectfully submitted that the rejection of claims 1-20 as obvious is improper.

Furthermore, in rejecting claims 1-20 as obvious, it is respectfully suggested that improper hindsight has been used. Tsutsumi et al. fails to teach or suggest the features of claims 1-20. Thus, without reference to the teachings of the disclosure of the present invention, one of ordinary skill in the art would not have the requisite knowledge to modify Tsutsumi et al. as suggested by the Office Action.

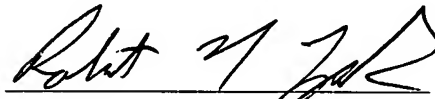
According to In Re Sponnoble, 160 USPQ at 243 (CCPA 1969), such hindsight is impermissible. Therefore, it is respectfully submitted that for this further reason, the rejection of claims 1-20 is improper.

Allowance of the subject application is respectfully requested.

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Please charge any deficiency or credit any overpayment in
the fees for this election to our Deposit Account No. 20-0090.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert N. Lipszick", written over a horizontal line.

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